

REMARKS

Claims 1-49 are currently pending in the application. Claims 3-5 and 8-10 were withdrawn from consideration following a restriction requirement. Claims 1-2, 6-7 and 11-49 are original. Applicant notes with appreciation that claims 47-49 are allowed and claims 26, 27, 45 and 46 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claims 1-2, 11-12, 14-15, 21-25, 28-30, 34 and 40-41 stand rejected under 35 U.S.C. 102(e) as being anticipated by Potter (U.S. Patent No. 6,854, 330, "Potter"). Claims 6-7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of Trzaskos (U.S. Patent No. 4,382,201, "Trzaskos"). Claims 13, 31-33 and 42-44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of Greer, Jr. (U.S. Patent No. 4,764,908, "Greer"). Claims 16-20 and 35-39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of Rike (U.S. Patent No. 2,776,010).

Summary of the Telephonic Interview

The undersigned and the Examiner conducted a telephonic interview on April 4, 2006. The undersigned wishes to thank the Examiner for the courtesies extended during the telephonic interview.

The undersigned attempted to clarify the rejection since there was some confusion caused by what seemed to be erroneous referencing of numbered elements used in the rejection of various claims. During the interview, the undersigned highlighted some inconsistencies in the Office Action with respect to referencing numbered elements cited from the Potter reference. For example, the Action refers to two elements within Potter, a chamber and a spring, each designated, according to the Action, with reference numeral 24. However, as pointed out by the undersigned, and acknowledged by the Examiner, Potter does not describe a spring, at all. The undersigned also explained the applicant's position in regard to the rejection of independent claims 1 and 28. These positions are discussed more fully below. The Examiner encouraged the undersigned and the applicant to file a response more fully presenting these arguments.

Response to rejection under §102

Applicant hereby traverses the rejection and respectfully requests reconsideration in view of the remarks set forth below.

As stated in the MPEP §2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 recites an apparatus for sensing motion of a referenced surface comprising a shell, a case within the shell and a suspension such that that case is coupled to the shell with the suspension. The mass of the case is recited to be greater than the mass of the shell. Claim 28 recites similar subject matter. Potter fails to describe a case or suspension as recited in the claim.

The Office Action asserts that Potter describes each and every one of these elements. Specifically, the Office Action asserts that Potter discloses an apparatus "20(1)...comprising: a shell (housing 22), a case (chamber 24) within the shell and a suspension (spring 24)..." Applicant respectfully disagrees. As discussed in the telephonic interview and acknowledged by the Examiner, Potter does not, in fact, disclose a spring. The Action makes no other assertion that Potter describes any other suspension. Thus, Applicant traverses the §102 rejection as it fails to establish, as required by MPEP § 2131, that each and every element set forth in the claim is found.

In addition, the Office Action asserts that Potter describes the case as recited in claims 1 and 28 in the form of a chamber 24. Applicant disagrees. Chamber 24 is merely a cavity on the inside of the housing 22 formed from the removal of sacrificial materials 52 and 58 from the interior of housing 22 (See Figures 7 and 8 and column 6, lines 24-45). The chamber 24 in Potter is simply a region in space bounded by the housing. In contrast, the case recited in claims 1 and 28, instead of being an empty region, has a mass. More particularly, as explicitly recited in claims 1 and 28, the

case has a mass which is greater than the shell, a feature the Action asserts is inherently met in Potter. However, chamber 24, a void, could not possibly have a higher mass than the recited shell, and thus could not be the case recited in independent claims 1 and 28.

Moreover, "to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Office Action fails to include any evidence or technical reasoning to support the allegation. By merely stating that the mass limitation is "inherently met in the reference", the Office Action fails to comply with the requirements set forth in the MPEP and case law. For these additional reasons, Applicant requests reconsideration and withdrawal of the §102 rejections of independent claims 1 and 28.

Trzaskos teaches improvements to a high frequency ultrasonic transducer and a process for obtaining high levels of acoustic attenuation in a tungsten-polyvinyl chloride composite. Greer teaches a magnetohydrodynamic sensing device having shock resistant characteristics. Rike teaches a method for cementing in a borehole penetrating porous strata and earth formations. These references fail to cure the deficiencies of independent claims 1 and 28.

CONCLUSION

At least for these reasons, applicant believes that claims 1 and 28 are in condition for allowance. Claims 2-27 and 29-46 depend, directly or indirectly, from claim 1 and are also patentable for at least for the same reasons that claims 1 and 28 are patentable.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Application No. 10/713499
Amendment dated May 10, 2006
Reply to Office Action of February 10, 2006

Docket No.: BBNT-P01-138

Applicant believes no fee is due with this response other than as reflected on the enclosed Fee Transmittal. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. BBNT-P01-138 from which the undersigned is authorized to draw.

Dated: May 10, 2006

Respectfully submitted,

By 

Edward A. Gordon

Registration No.: 54,130

ROPES & GRAY LLP

One International Place

Boston, Massachusetts 02110-2624

(617) 951-7000

(617) 951-7050 (Fax)

Attorneys/Agents For Applicant